



IN THE SPECIFICATION:

Page 11, line 22, after "friction lining" insert -- 42 --;
line 23, after "rotor lining" insert -- 52 --.

IN THE CLAIMS:

Please rewrite claim 15 as the following:

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15.⁴ (Amended) A brake disk assembly according to claim ~~13~~², wherein the assembly includes one of a pressure plate and an end plate with a wear portion of about two times the thicknesses of the other one of said pressure plate and said end plate.

REMARKS

The drawings have been objected to as failing to comply with 37 CFR § 1.84(p)(5) because they include elements 37 and 52 shown in FIG. 1. Corrected FIG. 1 is included to delete element 37. Element 52 is described clearly on page 11 of the specification as the rotor lining in FIG. 1. No new matter is added to the application.

The drawings were objected to under 37 CFR § 1.83(a). The Examiner noted that the drawings must show every feature of the invention specified in the claims. The Applicants respectfully submit that the drawings do show the different thicknesses of the wear portions of the brakes and respectfully request further clarification from the Examiner or withdrawal of this objection.

Claims 1-5 and 11-16 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular with respect to claims 1, 11, 13 and 16, the Examiner has questioned whether the first, second and third thicknesses apply to the brake disks in general or the wear portions. As explained on pages 10 -13 of the specification, the brake disk can be any type of brake disk, solid or segmented. Desirably, the brake disk has available wear surfaces that can be refurbished or replaced. The disks of the assembly comprise disks of three different available wear portions. Disks of a first thickness have an initial wear portion, disks of a second thickness have two thirds of the initial wear portion of the first thickness disks and disks of a third thickness have one third of the initial wear portion of the first thickness disks. At the

overhaul, the available wear portion of the first thickness disks is equal to the initial available wear portion of the second thickness disks and so forth.

Claim 15 has been amended to properly reference the brake assembly of the independent claim 13 [See Appendix A].

Claims 1-16 have been rejected under 35 U.S.C. § 103 (a) as being unpatentable over Bok '895. The Examiner admits that Bok "does not specifically disclose that the disks of a second and third thickness have two thirds and one third, respectively, of the initial wear portion of the first thickness disks..." Additionally, the Examiner has admitted that Bok fails to disclose all three thickness disks positioned in a brake assembly. However, the Examiner insists that one of ordinary skill in the art would optimize system performance by utilizing appropriate disks. Furthermore, the Examiner alleges it would have been obvious to one of ordinary skill in the art to have constructed the brake assembly of Bok with a third thickness disks in order to improve the braking efficiency.

Applicants respectfully submit that the Examiner has utilized improper hindsight in rendering this rejection. As explained by the Federal Circuit in *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), "[t]o imbue one of ordinary skill in the art with knowledge of the invention...when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher...." Bok '895 simply does not teach, or even suggest directly or indirectly, a brake assembly wherein the brake disks axially aligned and disposed between a pressure plate and an end plate are comprised of disks of three different wear portions.

Furthermore, the Examiner has failed to point to anything that would suggest that disks having three different wear portions are used by Bok '895. Rather Bok '895 is concerned with a brake assembly having only a first group of disks and a second group of disks. The first group of disks are substantially fully worn after a predetermined number of brake applications and are replaced. Nowhere is there a three run disk brake stack and method of assembly disclosed in Bok '895.

Claim 1 was also provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the corresponding application 09/449,033 in

view of Bok '895. According to the Examiner, it would have been obvious to one of ordinary skill in the art in view of the teachings of Bok '895 to have constructed the brake assembly of the '033 application in order to maintain a minimum piston travel or heat sink mass through the wear life of the brake assembly. Applicants disagree.

First, the Examiner has not shown any motivation to combine the two teachings.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so... The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

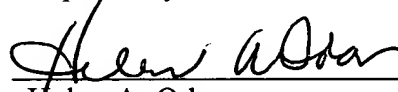
Second, even if combined, the combination would not yield a brake assembly comprising an end plate, a pressure plate and brake disks axially aligned and disposed therebetween, where the brake disks are comprised of disks of three different wear portions in the assembly itself as claimed in the instant application.

Claim 6 was also provisionally rejected under the doctrine of obviousness-type double patenting as being unpatentable over claim 9 of the '033 application in view of Bok '895. Once again, Applicants respectfully disagree. There is no motivation to combine the teachings as suggested by the Examiner. Even assuming for the sake of argument that the combination was proper (which Applicants deny), one still would not have a method of assembling and overhauling a disk brake having a plurality of disks with *three different* available wear portions.

In conclusion, Applicants respectfully submit that the references or combination of references cited against claims do not render the claims obvious, directly or indirectly. Therefore, Applicants submit that all pending claims are allowable in their present form and hereby request allowance in a timely manner.

Dated: March 19, 2001

Respectfully submitted,



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APPENDIX A

15. (Amended) A brake disk assembly according to claim 13, wherein [each] the assembly includes one of a pressure plate and an end plate with a wear portion of about two times the thicknesses of the other one of said pressure plate and said end plate.

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